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Charles H. Lenore

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CANTOR COLBURN, LLP

20 Church Street

22nd Floor

Hartford, CT 06103

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* CHARLES H. LENORE and ROBERT A. BROOKS
9

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11 Appeal 2008-1488
12 Application 10/020,616
13 Technology Center 3600
14

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16 Decided: June 19, 2008
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19 Before TERRY J. OWENS, ANTON W. FETTING, and DAVID B. WALKER,
20 *Administrative Patent Judges.*

21 FETTING, *Administrative Patent Judge.*

22 DECISION ON APPEAL

23 STATEMENT OF CASE

24 Charles H. Lenore and Robert A. Brooks (Appellants) seek review under
25 35 U.S.C. § 134 of a final rejection of claims 1-46, the only claims pending in the
26 application on appeal.

27 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

28
29 We AFFIRM.

1 The Appellants invented a way of managing and providing access to legal
2 information by creating, editing and accessing an evidentiary outline (Specification
3 1:5-7).

4 An understanding of the invention can be derived from a reading of exemplary
5 claim 1, which is reproduced below [bracketed matter and some paragraphing
6 added].

7 1. A method for managing legal information related to at least one
8 legal matter in a system including a legal enterprise and a storage
9 system coupled via a network, the method comprising:

10 [1] storing legal information in a database associated with the storage
11 system, said legal information including

12 [1.1] an evidentiary outline

13 corresponding to said legal matter,

14 the evidentiary outline including

15 [1.1.1] a party's position and

16 [1.1.2] a link to evidence stored in the database
17 supporting the party's position,

18 [1.1.2.1] the link created by a contributor

19 having authority to modify legal
20 information in the database; and

21 [2] providing the legal information to a client via the network.
22

23 This appeal arises from the Examiner's final Rejection, mailed May 4, 2006.
24 The Appellants filed an Appeal Brief in support of the appeal on November 20,
25 2006. An Examiner's Answer to the Appeal Brief was mailed on May 7, 2007.

PRIOR ART

The Examiner relies upon the following prior art:

Simpson US 6,549,894 B1 Apr. 15, 2003

Krachman US 6,738,760 B1 May 18, 2004

David H. Griggs, Embracing the Virtual Office Concept: How Legal Anywhere
Collaborator! Can Help, Legal Tech, Vol. 17, No. 11, February 2000

REJECTIONS

Claims 1-4, 16-19, and 30-36 stand rejected under 35 U.S.C. § 103(a) as
unpatentable over Krachman and Simpson.

Claims 5-15, 20-29, and 37-46 stand rejected under 35 U.S.C. § 103(a) as
unpatentable over Krachman, Simpson, and Griggs.

ISSUES

The issues pertinent to this appeal are

- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1-4, 16-19, and 30-36 under 35 U.S.C. § 103(a) as unpatentable over Krachman and Simpson.
- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 5-15, 20-29, and 37-46 under 35 U.S.C. § 103(a) as unpatentable over Krachman, Simpson, and Griggs.

The pertinent issue turns on whether the link in element [1.1.2] of claim 1 would have been a predictable data item using the combination of Krachman and Simpson.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are supported by a preponderance of the evidence.

Krachman

01. Krachman is directed to searching and managing data relevant to legal activity using artificial intelligence technology (Krachman 2:10-13).

02. Krachman trains its neural network with pleadings, proof of facts, fact chronologies/issues, investigation reports, and deposition transcripts (Krachman 3:31-53). A key feature of Krachman is the ability to feed key pleadings, discovery responses and other data, such as the target database, into an intelligent reader, and use standard or proprietary neural network/AI software to develop a search algorithm. In other words, an electronic query, such as a discovery request, would be formulated by the software and then converted to smart search agents or "bots" by training of the neural network (Krachman 3:60-67).

03. Krachman describes smart search agents that run through the target and extract responsive data. The results are saved in various forms, including, summaries, indexes (such as for a privilege index), in addition to the documents themselves (Krachman 4:27-35).

04. Krachman describes how either the requestor or the respondent can send input information to an electronic discovery server, or how the electronic discovery server can be controlled by a third party supervisory body which will obtain input from both parties in order to control the discovery process (Krachman 4:53-62).

1 05. Krachman describes its litigator tool as a document production agent.
2 It uses an AI search agent that "learns and understands" the content,
3 context, and objective of the requester, and then applies this
4 understanding to the electronic search of the target's electronic files. For
5 litigation purposes, the software can feature automated privileged
6 indexes (Krachman 5:34-46).

7 06. Krachman describes its diligencer tool for due diligence for mergers,
8 acquisitions, securities and environmental and other regulatory
9 compliance. The diligencer tool uses search agents to cut time expense
10 dramatically from these processes and allows for high-speed, real-time
11 document identification, retrieval and analysis. This diligencer tool
12 comprises an AI based search system which is used in mergers and
13 acquisitions and due diligence to check for problematic electronic
14 documents in connection with an acquisition, such as evidence of sexual
15 harassment in the target companies electronic systems (Krachman 5:66-
16 6:16).

17 07. Krachman describes how its system provides verification and data
18 integrity. Due to the inherent susceptibility of computer data to subtle
19 modification or alteration, challenges to admissibility and foundation
20 issues are key problems in the litigation arena. Krachman provides deep
21 level information on the date of creation, author, modification dates and
22 attributes which affect the integrity of the data. The data integrity
23 information can appear as a stamp or bar code on recovered documents.
24 The bar code data would then support, or undermine, when appropriate,
25 the integrity of the data sought to be admitted during litigation or other
26 proceeding (Krachman 7:5-16).

1 08. Krachman can reprint all responsive documents, affix the integrity
2 code, segregate the documents according to which document request
3 they correspond, Bates stamp the documents, print out copies of all
4 potentially privileged documents, and all potentially confidential,
5 protective order documents, and generate a draft privilege index
6 (Krachman 7:26-33).

7 09. Krachman describes how its Defensive Document Inspection output
8 contains both the full text of responsive documents and a draft privilege
9 index (Krachman 7:41-50).

10 10. Krachman describes how its Offensive Document Inspection output
11 indexes the opponent's existing databases with hyperlinks to full text
12 (Krachman 7:64 – 8:6).

13 11. Krachman describes how its Private E-Discovery Service generates
14 indexes with hyperlinks to full text (Krachman 8:20-27).

15 *Simpson*

16 12. Simpson is directed to a computerized docketing system for legal
17 matters, comprising a database arranged to store information related to
18 the legal matters, including actions to be taken with respect to the legal
19 matters, and due dates associated with the actions to be taken. The
20 system is arranged to scan the database, compare each of the due dates
21 with a reference date, and classify the due dates according to proximity
22 of each of the due dates to the reference date (Simpson 3:36-44).

23 13. Simpson describes how, for security purposes, only authorized users
24 are allowed to access the docketing program. For example, some users
25 are given full read/write ability; whereas others are given read only

1 ability. In a typical installation, a docketing administrator would be
2 given full read/write authority, while responsible attorneys would be
3 given read only authority. Thus, a docketing administrator could modify
4 due dates and docket actions, but an attorney could only browse docket
5 actions screens without being able to change any due dates (Simpson
6 5:36-46).

7 *Griggs*

8 14. Griggs is directed to a product, Legal Anywhere, for the virtual office
9 tailored specifically for the legal profession (Griggs 1: Second ¶ under
10 Body).

11 15. Griggs describes how Legal Anywhere can limit access to its data
12 (Griggs 2:Third full ¶).

13 16. Griggs describes how Legal Anywhere has taken measures to ensure
14 that client information is as secure as the most current encryption levels
15 allow (Griggs 3:Fourth ¶).

16 *Facts Related To The Level Of Skill In The Art*

17 17. Neither the Examiner nor the Appellants has addressed the level of
18 ordinary skill in the pertinent arts of programming, system design, legal
19 analysis, evidentiary administration, database design, hypermedia
20 organization, and legal administration. We will therefore consider the
21 cited prior art as representative of the level of ordinary skill in the art.
22 *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he
23 absence of specific findings on the level of skill in the art does not give
24 rise to reversible error ‘where the prior art itself reflects an appropriate
25 level and a need for testimony is not shown’”) (quoting *Litton Indus.*

1 uncommon definition in some manner within the patent disclosure so as to give
2 one of ordinary skill in the art notice of the change).

3 *Obviousness*

4 A claimed invention is unpatentable if the differences between it and the
5 prior art are “such that the subject matter as a whole would have been obvious at
6 the time the invention was made to a person having ordinary skill in the art.”
7 35 U.S.C. § 103(a) (2000); *KSR Int’l v. Teleflex Inc.*, 127 S.Ct. 1727 (2007);
8 *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

9 In *Graham*, the Court held that that the obviousness analysis is bottomed on
10 several basic factual inquiries: “[(1)] the scope and content of the prior art are to be
11 determined; [(2)] differences between the prior art and the claims at issue are to be
12 ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved.” 383
13 U.S. at 17. *See also KSR Int’l v. Teleflex Inc.*, 127 S.Ct. at 1734. “The
14 combination of familiar elements according to known methods is likely to be
15 obvious when it does no more than yield predictable results.” *KSR*, at 1739.

16 “When a work is available in one field of endeavor, design incentives and
17 other market forces can prompt variations of it, either in the same field or a
18 different one. If a person of ordinary skill can implement a predictable variation,
19 § 103 likely bars its patentability.” *Id.* at 1740.

20 “For the same reason, if a technique has been used to improve one device,
21 and a person of ordinary skill in the art would recognize that it would improve
22 similar devices in the same way, using the technique is obvious unless its actual
23 application is beyond his or her skill.” *Id.*

24 “Under the correct analysis, any need or problem known in the field of
25 endeavor at the time of invention and addressed by the patent can provide a reason
26 for combining the elements in the manner claimed.” *Id.* at 1742.

Automation of a Known Process

It is generally obvious to automate a known manual procedure or mechanical device. Our reviewing court stated in *Leapfrog Enterprises Inc. v. Fisher-Price Inc.*, 485 F.3d 1157 (Fed. Cir. 2007) that one of ordinary skill in the art would have found it obvious to combine an old electromechanical device with electronic circuitry “to update it using modern electronic components in order to gain the commonly understood benefits of such adaptation, such as decreased size, increased reliability, simplified operation, and reduced cost. . . . The combination is thus the adaptation of an old idea or invention . . . using newer technology that is commonly available and understood in the art.” *Id* at 1163.

Obviousness and Nonfunctional Descriptive Material

Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). Cf. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

ANALYSIS

Claims 1-4, 16-19, and 30-36 rejected under 35 U.S.C. § 103(a) as unpatentable over Krachman and Simpson.

The Appellants argue these claims as a group.

Accordingly, we select claim 1 as representative of the group.
37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Examiner found that Krachman described all of the limitations of claim 1 except for limitation [1.1.2.1], *viz.* a contributor having authority to modify the information being the one to create the link of limitation [1.1.2].

1 The Appellants contend that Krachman fails to describe limitation [1.1.2], a
2 link to evidence stored in the database supporting the party's position and that
3 Simpson fails to describe limitation [1.1.2.1], a contributor having authority to
4 modify the information being the one to create the link of limitation [1.1.2] (Br. 4-
5 5). The Appellants contend that what the Examiner cited Krachman for in support
6 of limitation [1.1.2] describes a search criterion entered into search fields, and not
7 a link. The Appellants also contend that Simpson fails to describe using its access
8 feature for modifying legal information in an evidentiary database, and that
9 Simpson's links are to forms rather than to evidence stored in a database. [CITE]

10 We disagree with the Appellants. We initially find that the Appellants do not
11 dispute whether the applied art describes limitations [1], [1.1], [1.1.1], or [2] and
12 that Krachman does describe these limitations. Limitation [1] of storing legal
13 information in a database is described by Krachman's overview (FF 01).
14 Limitation [1.1] of an evidentiary outline including limitation [1.1.1] of a party's
15 position is described by Krachman's high level discovery documents, such as
16 pleadings, proof of facts, fact chronologies/issues used to train Krachman's neural
17 network, which also becomes an evidentiary outline once trained (FF 02).
18 Limitation [2] of output is described by Krachman's outputs (FF 07, 08, 09, 10, &
19 11).

20 Krachman describes links from its evidentiary outline to evidence in the form
21 of indexes and hyperlinks to source documents (FF 07, 08, 09, 10, & 11).
22 Although Krachman creates these links from artificial intelligence queries,
23 Krachman memorializes these links as indexes and hyperlinks. Thus, we find that
24 Krachman does describe the link to evidence in the form of supporting documents
25 that support the party's position as in limitation [1.1.2].

1 We also find that Simpson describes setting user security levels in a legal
2 information system (FF 12 & 13). Simpson implies that only those responsible for
3 maintaining data are authorized to change it. In Simpson's case, only docketing
4 persons may alter docketing data. This is simply administrative internal control
5 procedure. Applying this principle to Krachman, those responsible for certain data
6 would have authority to change it. Ongoing data integrity simply requires that the
7 one who creates a link to data should have the authority to change the link or the
8 data if either becomes invalid. Thus, limitation [1.1.2.1] of claim 1 is simply
9 applying Simpson's administrative internal control practice to Krachman's
10 database. "Common sense teaches ... that familiar items may have obvious uses
11 beyond their primary purposes, and in many cases a person of ordinary skill will be
12 able to fit the teachings of multiple patents together like pieces of a puzzle." *KSR*,
13 127 S. Ct. at 1742.

14 The Appellants also argued that Simpson's links were to forms rather than
15 evidence (Br. 5), to counter the use of Simpson as describing links in limitation
16 [1.1.2]. This argument is unpersuasive in view of Krachman's use of hyperlinks,
17 *supra*.

18 The Appellants have not sustained their burden of showing that the Examiner
19 erred in rejecting claims 1-4, 16-19, and 30-36 under 35 U.S.C. § 103(a) as
20 unpatentable over Krachman and Simpson.

21 *Claims 5-15, 20-29, and 37-46 rejected under 35 U.S.C. § 103(a) as unpatentable*
22 *over Krachman, Simpson, and Griggs.*

23 The Appellants argue these claims as a group, but also make additional
24 arguments to the subgroup of claims 9, 24, and 41 (Br. 6). We therefore treat the
25 claims as being argued in two groups.

1 The first group consists of claims 5-8, 10-15, 20, 23, 25-29, 37-40, and 42-46.
2 We select claim 5 as representative of the group.

3 The second group consists of claims 9, 24, and 41. We select claim 9 as
4 representative of the group.

5 As to all of claims 5-15, 20-29, and 37-46, the Appellants argue they are
6 patentable for the same reasons as claim 1 (Br. 7). We found those reasons to be
7 insufficient to overcome the Appellants' burden *supra*, and we therefore find those
8 reasons to be similarly insufficient as to these claims.

9 Claim 5 further requires enabling the contributor to edit the link to evidence in
10 the database. The Examiner found that Griggs describes enabling an attorney to
11 grant editing rights in a case. The Examiner implicitly found one of ordinary skill
12 would have known it was desirable to grant access rights to clients and other law
13 firms while maintaining security over a network by selectively granting such
14 editing rights and concluded it was obvious to provide such editing rights to the
15 evidentiary database in claim 1 (Answer 8).

16 The Appellants contend that Griggs provides no enablement and is not directed
17 to a link to evidence supporting a party's position (Br. 6). We disagree with the
18 Appellants. Griggs describes a working product, which is all that is required to
19 enable Griggs for the purpose of prior art. Of more importance, Griggs is only
20 applied to show the practice of limiting access to data as appropriate (FF 15).
21 Since Krachman can update its links by rerunning its software agents, Krachman
22 provides the capacity to edit its links. Thus, Griggs is only applied for the rather
23 unremarkable feature of limiting access as appropriate. Clearly the party who
24 submitted an item of evidence is in the best position to determine whether that item
25 needs to be edited. Thus, that party would be a predictable party to whom

1 authority for such editing would be given. “The combination of familiar elements
2 according to known methods is likely to be obvious when it does no more than
3 yield predictable results.” *KSR*, 127 S. Ct. at 1739.

4 Claim 9 further requires encrypting the legal information prior to transmission
5 to storage. The Examiner found that Griggs discloses encrypting data (Answer 9).

6 The Appellants contend that Griggs does not describe that legal information is
7 encrypted prior to transmission to a storage system (Br. 7). Griggs is only applied
8 to show the practice of encrypting data as appropriate (FF 16). Since Krachman
9 stores its data in a legal database, Krachman provides the storage and transmission
10 to storage limitations. Thus, Griggs is only applied for the rather unremarkable
11 feature of encrypting as appropriate. Clearly encryption is beneficial for data that
12 is to be secured, such as that in Krachman.

13 The Appellants have not sustained their burden of showing that the Examiner
14 erred in rejecting claims 5-15, 20-29, and 37-46 under 35 U.S.C. § 103(a) as
15 unpatentable over Krachman, Simpson, and Griggs.

16 CONCLUSIONS OF LAW

17 The Appellants have not sustained their burden of showing that the Examiner
18 erred in rejecting claims 1-46 under 35 U.S.C. § 103(a) as unpatentable over the
19 prior art.

20 On this record, the Appellants are not entitled to a patent containing claims 1-
21 46.

DECISION

To summarize, our decision is as follows:

- The rejection of claims 1-4, 16-19, and 30-36 under 35 U.S.C. § 103(a) as unpatentable over Krachman and Simpson is sustained.
- The rejection of claims 5-15, 20-29, and 37-46 under 35 U.S.C. § 103(a) as unpatentable over Krachman, Simpson, and Griggs is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

JRG

CANTOR COLBURN, LLP
20 Church Street
22nd Floor
Hartford, CT 06103